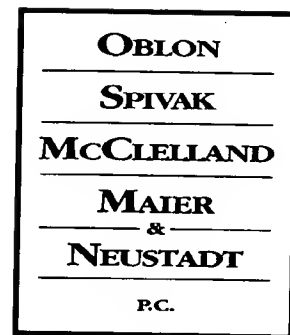




Docket No.: 216583US0X CONT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231



ATTORNEYS AT LAW

RE: Application Serial No.: 09/996,591
Applicants: Tamotsu KONDOW, et al.
Filing Date: November 30, 2001
For: METHODS FOR DETERMINING NUCLEOTIDE
SEQUENCES OF SINGLE NUCLEIC ACID
MOLECULES
Group Art Unit: 1634
Examiner: Lu, Frank Wei Min

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SIR:

Attached hereto for filing are the following papers:

Response to Restriction Requirement

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon

Registration No. 24,618



22850

(703) 413-3000 (phone)
(703) 413-2220 (fax)

Vincent K. Shier, Ph.D.
Registration No. 50,552

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :
Tamotsu KONDOW, et al. : GROUP ART UNIT: 1634
SERIAL NO.: 09/996,591 :
FILED: NOVEMBER 30, 2001 : EXAMINER: LU
FOR: METHODS FOR DETERMINING NUCLEOTIDE SEQUENCES OF SINGLE
NUCLEIC ACID MOLECULES

RESPONSE TO RESTRICTION REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the Official Action dated November 18, 2002, Applicants elect, with traverse, Species (a) and Species (c), as defined below, for further prosecution. Claims 1-11 read on Species (a) and Claims 1-8, 10, and 11 read on Species (c).

REMARKS

The Office has required restriction in the present application as follows:

- (a) nucleotide sequencing in the presence of an immobilized nucleic acid template and a primer solution; and
- (b) nucleotide sequencing in the presence of an immobilized primer and a nucleic acid template solution.

In addition, the Office is requiring an election from:

- (c) DNA polymerase and dNTP; and
- (d) RNA polymerase and NTP.

Applicants elect, with traverse, Species (a) and Species (c), as defined above, for further prosecution. Claims 1-11 read on Species (a) and Claims 1-8, 10, and 11 read on Species (c).

Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the species as claimed. MPEP §808.01(a). Applicants respectfully traverse the Election of Species Requirement on the grounds that the Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants' election of species is for examination purposes only.

Moreover, the MPEP in §803 states as follows:

"If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office.

Finally, with respect to the elected species, Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Election of Species Requirement. Withdrawal of the Election of Species Requirement is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No.: 24,618

Vincent K. Shier, Ph.D.
Registration No.: 50,552



22850

PHONE NO.: (703) 413-3000
FAX NO.: (703) 413-2220
NFO:VKS
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